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InventorshipYohanan
5 Assignee Microsoft Corporation
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Examiner S. Sax
Attorney's Docket No.MS1-1074USC3
10 Title: Graphical Method and System for Accessing Information on a
Communications Network

APPEAL BRIEF TO THE BOARD OF PATENT APPEALS AND
INTERFERENCES OF THE UNITED STATES PATENT OFFICE

To: Commissioner for Patents
PO Box 1450
15 Alexandria, VA 22313-1450

From: Brian J. Pangrle
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201
20

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Appellant's Opening Brief on Appeal

This opening brief is presented in support of the Notice of Appeal filed on
May 12, 2003 from the final rejection of claims 3-12 of the above identified
application. The Final Office Action which Appellant hereby appeals was
25 mailed March 12, 2003.

The Appeal Brief is filed in triplicate. A check or deposit account form for
the amount of \$ 330.00 is enclosed for the requisite fee set forth in 37 C.F.R. §
1.17(f). Please charge any additional required fees or credit overpayment to
Deposit Account 120769. Appellant respectfully requests reversal of the
30 Office's rejection of pending claims 3-12.

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Real Party in Interest

The present application has been assigned to Microsoft Corporation, a corporation organized and existing under and by virtue of the laws of the State of Washington and having an office and place of business at One Microsoft
5 Way, Redmond, Washington 98052, in an assignment filed for recordation filed on July 12, 2002 with the USPTO. Therefore, the real party in interest is Microsoft Corporation.

Related Appeals and Interferences

10 There are no other appeals or interferences known to Appellant/Applicant which will have a bearing on the Board's decision in the present appeal.

Status of the Claims

15 Nine claims are pending in this application. The Office has rejected claims 3-12. These claims are the subject of the present appeal.

Status of the Amendments

In an Office Action mailed July 27, 2000, the Office rejected claims 1 and
20 2. A Response dated October 27, 2000 added new claims 3-8. In an Office Action mailed January 8, 2001, the Office rejected claims 3-8. A Terminal Disclaimer was filed thereafter and another Office Action was mailed August 17, 2001, in which claims 3-8 were rejected. On September 28, 2001, Silicon Graphics, Inc. assigned the instant application, related applications and patents
25 to Microsoft Corporation. A Declaration under 37 C.F.R. §1.111 was filed on November 19, 2001 and a Final Office Action was mailed February 14, 2002, in which claims 3-8 were rejected. On July 12, 2002, the new assignee Microsoft Corporation filed a Supplemental Information Disclosure Statement under 37 C.F.R. §1.56.

On July 12, 2002, a Response was filed to the Final Office Action along with a Request for Continued Examination under 37 C.F.R. §1.114. In this Response, new claims 9-12 were added. In an Office Action mailed August 15, 2002, the Office rejected claims 3-12. In a Response dated December 16, 2002, Applicant requested amendment of independent claims 3-6 and 9-12. These amendments were entered and in a Final Office Action dated March 12, 2003, the Office rejected claims 3-12. A Notice of Appeal was filed May 12, 2003. The pending claims listed in the Appendix reflect the current claims 3-12.

10 **Summary of the Invention**

In 1994, most web browsers required entry of a web site address or URL in a specialized text field prior to accessing a web site and few resources were available to organize addresses or facilitate access to web sites from a desktop. Some web browsers permitted users to store frequently accessed network locations through use of a "bookmark". As stated in the Related Art section of the instant application, "[t]hrough the use of a bookmark, once a browser is opened, the user may be able to quickly access a favorite site by selecting a bookmark previously designated to mark the location of that site." Application at page 3, lines 15-20. Such bookmarks, however, were web browser specific and implemented via web browser software.

To overcome such shortcomings, the inventor (Mr. Yohanan) developed more efficient methods for accessing web sites. Some of these new methods and associated code appear in Declaration that was filed under 37 C.F.R. § 1.131 in response to an Office Action dated August 17, 2001 (Paper No. 10), which was used to demonstrate that the inventor conceived and reduced to practice the claimed invention prior to January 1, 1995. This Declaration includes Exhibit A, which is a four page email that describes a problem associated with navigating the web and organizing URLs. As a solution to the problem, the inventor described an icon that can be selected to run a web browser and access a particular web site address (e.g., a URL). The four page

email includes example code and other statements that describe use of such an icon to achieve various goals.

The instant continuation application, which claims priority to a parent application filed on December 29, 1995, includes subject matter of the

5 aforementioned four page email. For example, the instant application discloses "a system and method for allowing a user to access a desired network location without having to first access a browser application". Application at page 6, lines 3-5. In one implementation, "a Graphical User Interface (GUI) icon is provided that allows the user to 'jump' directly to the designated network

10 location. When the user selects the icon (e.g., by double-clicking on the icon), a browser application is automatically opened and the designated network location is accessed." Application at page 6, lines 5-9. According to various examples, selection of an icon (e.g., double-clicking, etc.) may launch a web browser or an instance of a web browser or cause a currently executing web

15 browser to access a web site. E.g., Application at page 19, lines 2-12. An icon may also be an object associated with a file. Application at page 6, lines 19-22. Such a file may be separate from any web browser application. For example, such a file may be manipulated using standard file operations wherein such "file operations are independent of the identity of a particular icon being operated

20 upon." Application at page 7, lines 7-12. Further, in various examples, "icons can be copied by disk, attached to e-mail messages and otherwise transported to other systems. In this manner, jumpsite icons attach to e-mail messages in a similar manner that document files, or the like, are attached to conventional Internet messages." Application at page 14, line 23 to page 15, line 1. These

25 examples are not exhaustive but are rather presented to help summarize the invention and demonstrate that subject matter of claims 3-12, discussed below, is fully supported by the instant application and the parent application, as filed.

Issues Presented for Review

1. Were claims 3, 9, 10, 11 and 12 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906)?

5 2. Was claim 4 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906)?

3. Was claim 5 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle
10 (U.S. Pat. No. 5,838,906)?

4. Were claims 6, 7 and 8 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906)?

15 **Grouping of Claims**

Applicant submits that claims 3-12 fall into four groups: Group I includes claims 3 and 9-12; Group II includes claim 4; Group III includes claim 5; and Group IV includes claims 6, 7 and 8. Claim Groups I-IV do not stand or fall together for at least the reasons presented below and for other reasons
20 presented in the Arguments section.

Group I

Group I includes independent claims 3 and 9-12. These independent claims recite a desktop icon on a desktop associated with an address of a web site wherein selection of the desktop icon by a user launches a web browser
25 application that can access the web site using the address. Claim 3 is a method claim; claims 9 and 10 are computer-readable media claims; claim 10 is directed to a desktop icon; and claim 12 is directed to a graphical interactive system. While the claims are presented in the Appendix, for sake of convenience claim 3 is also presented below:

A graphical interactive method for permitting a computer system to access a web site, the method comprising the steps of:
displaying a desktop icon on a desktop, said desktop icon associated with an address of the web site;

5 launching a web browser application in response to a user of said computer system selecting said desktop icon for execution; and

accessing the web site using said web browser application and said address of the web site.

Group II

Group II includes method claim 4 that recites a desktop icon associated with a file containing information relating to a web site accessible via a web browser application wherein the web browser application is separate from the
15 file. The claims of Group I do not recite a file or a relationship or lack thereof between a file and a web browser application. For at least these reasons, the Group II claim is separately patentable. Therefore, Applicant submits that the Group II claim cannot fall for the same reasons as Group I claims. Applicant submits that any rejection under 35 U.S.C. §103 of the Group II claim must rely
20 on a references that teaches, suggests or discloses at least such a file and a relationship or a lack thereof.

Group III

Group III includes independent claim 5, which is directed to a graphical computer system for accessing a desired document located at a network
25 location. Claim 5 recites retrieving the desired document from a network location using a web browser application and a network address via selection of a desktop icon associated with a file containing the network address that corresponds to the network location of the document wherein the web browser application is separate from the file. The claims of Group I and Group II do not
30 specifically recite locating a desired document from a network location using a desktop icon. Group I and Group II claims recite accessing a web site. For at least these reasons, the Group III claim is separately patentable. Therefore, Applicant submits that the Group III claim cannot fall for the same reasons as

Group I claims or the Group II claim. Applicant submits that any rejection under 35 U.S.C. §103 of the Group III claim must rely on a reference that teaches, suggests or discloses at least such a recited file wherein the file contains the network address that corresponds to the network location of the document.

5 Group IV

Group IV includes claims 6, 7 and 8. Claim 6 is an independent claim while claims 7 and 8 depend from claim 6. Claim 6 is directed to a method. Claim 6 recites receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web
10 site. Claim 7 recites receiving an email while claim 8 recites receiving an internet message. The claims of Groups I-III do not specifically recite receiving a desktop icon at a first computer, from a second computer. For at least these reasons, Group IV claims are separately patentable. Therefore, Applicant submits that Group IV claims cannot fall for the same reasons as Group I
15 claims, Group II or Group III claims. Applicant submits that any rejection under 35 U.S.C. §103 of Group IV claims must rely on a reference that teaches, suggests or discloses at least such receiving of a desktop icon from a second computer wherein the desktop icon is associated with a file containing an address corresponding to a web site.

20 While Applicant has grouped claims 3-12 as presented above, Applicant does not make any admission that each of the claims 3-12 may not be argued in another forum as independently patentable and/or in other groupings.

Argument

25 Arguments are presented below in accordance with issues presented pertaining to claims of Groups I-IV, which were rejected under 35 U.S.C. § 103(a).

Standard under 35 U.S.C. § 103(a)

The standard for rejection of claims under 35 U.S.C. § 103(a) is as follows and quoted directly from In re Lee, 277 F.3d 1338, 61 USPQ2d 1430, 1433, 1434 (Fed. Cir. 2002):

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

* * *

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) . . . "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with . . . In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

* * *

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); . . . In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Lee, 61 USPQ.2d at 1433, 1434. (Applicant reserves the right to rely on any of the cited authorities that appear within this particular quote taken from In re Lee.).

5 The Office has the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To meet this burden, the Office must consider a proper temporal perspective in an effort to avoid improper hindsight reconstruction. For example, In re Kotzab states:

10 A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close
15 adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).
20

In re Kotzab, 217 F.3d at 1371 (emphasis added).

 A prima facie case of obviousness must comport with such applicable
25 law. A further recitation of the Office's burden is set forth in the M.P.E.P., which states:

 To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the
30 knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to
35 make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

M.P.E.P. § 2142.

Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

Circumstances Surrounding Origin & Proper Temporal Perspective

As set forth in various aforementioned authorities, an obviousness rejection must consider knowledge available to one of ordinary skill in the art. The time period is important for the Board and the Office must consider one of ordinary skill in the art at the time of the invention. Such casting of the mind back to the time of invention helps to prevent the subtle but powerful attraction of a hindsight-based obviousness analysis.

While the parent application of the instant application was filed on December 29, 1995, the aforementioned Declaration (Paper No. 10) demonstrated that the inventor conceived and reduced to practice the claimed invention prior to January 1, 1995. Thus, the Board and the Office must consider one of ordinary skill in the art prior to 1995.

For sake of establishing a proper temporal perspective, assignee Microsoft Corporation released the WINDOWS® 95® operating system in the latter half of 1995; thus, at the time of invention, one of ordinary skill in the art would not be familiar with such an operating system. Assignee Microsoft Corporation released the INTERNET EXPLORER® web browser in August 1995; thus, at the time of invention, one of ordinary skill in the art would not be familiar with various features of or methods of using this web browser. For example, a non-patent literature document entitled "Microsoft Introduces Internet Explorer", dated August 17, 1995, which is listed on an Information Disclosure Statement by Applicant, received by the Office July 17, 2002 and considered by the Office in August 2002, states:

5 It's integrated support for Windows Shortcuts means users can go from their desktops to any of their favorite web sites just by clicking a single icon, without having to launch their connectivity software separately, dial their service providers, open their Web browsers, and navigate to the desired Web sites.

"Microsoft Introduces Internet Explorer", Aug. 17, 1995, at page 2.

10 Certainly, this objective evidence supports a factual finding that such a single icon for use of the INTERNET EXPLORER® web browser was not known to one of ordinary skill in the art in prior to January 1, 1995. Hence, as discussed further below, there is no evidence of record to indicate that the subject matter of claims 3-12 was known or in use with respect to web browsers know in the art prior to 1995.

15 The foregoing information is offered as evidence of non-existence and hence non-obviousness of the subject matter of claims 3-12 by others at the time of invention, which was prior to 1995. As stated by the Court of Appeals for the Federal Circuit in Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) "evidence rising out of the so-called
20 'secondary considerations' must always when present be considered en route to a determination of obviousness." Further, per M.P.E.P. § 716.01(a), "[s]uch evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented" and "[a]s indicia of obviousness or unobviousness, such evidence may have relevancy" (citing Graham v. John
25 Deere Co., 383 U.S. 1, 148 USPQ 459 (1966); In re Palmer, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973)). Thus, Applicant respectfully requests the Board to consider this relevant evidence to establish a proper temporal perspective and non-obviousness of the subject matter of claims 3-12.

30

Group I: Claims 3 and 9-12

Claims 3 and 9-12 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). For at least the following reasons, Applicant respectfully submits that the Office erred in rejecting claims 3 and 9-12. More specifically, Applicant submits that the evidence relied upon by the Office does not support the rejections made under 35 U.S.C. § 103(a). Applicant also submits that the evidence presented herein and in the record supports non-obviousness of claims 3 and 9-12.

Claims 3 and 9-12 recite a desktop icon on a desktop associated with an address of a web site wherein selection of the desktop icon by a user launches a web browser application that can access the web site using the address.

Errors in the Rejection

Applicant asserts that the Office erred in rejecting claims 3 and 9-12. In the Office Action dated March 12, 2003, the Office stated that in the Cardinal reference “[a] desktop icon is displayed on a desktop, and when selected launches a browser and accesses the document from its storage location”. Applicant disagrees with this characterization of the Cardinal reference. In particular, as described below, the Cardinal reference discloses various types of icons, none of which are a desktop icon on a desktop capable of launching a web browser application to access a web site. Further, the “browser” disclosed in the Cardinal reference is an “item browser” and there is absolutely no suggestion in the Cardinal reference that this item browser could serve as the web browser recited in claims 3 and 9-12. According to the Cardinal reference:

Tools existing within the present invention include: (i) an item browser which allows for a precursory examination of information within a given view . . . (col. 10, lines 35-37).

* * *

The item browser window allows a user to observe detailed information concerning the current item. Such information includes the person who last modified each part of the item and the time of

modification. The item browser window, provides a user with further information about the modification history of a particular item (col. 11, lines 61-67).

5 Based on such evidence and Fig. 8 of the Cardinal reference, Applicant submits that one of ordinary skill in the art at the time of invention would know of no manner in which this item browser could serve as a web browser.

With respect to the Doyle reference, in the Office Action dated March 12, 2003, the Office stated that the Doyle reference “shows how a web address and
10 therefore a site is accessed via a link to an object”. The Office then stated that “[it] would have been obvious to a person with ordinary skill in the art to have a website accessed in Cardinal et al., in view of the linking in Doyle et al., because it would provide a convenient computer resource of information to be linked to an object, in a system that links resources of information to objects”.
15 However, even assuming arguendo that such a combination is proper, the Doyle reference fails to teach how the item browser of the Cardinal reference could be used to access a web site. Indeed, the Cardinal reference makes no mention of a “web browser” or even the word “web”. Thus, evidence for a motivation to combine these two references is lacking.

20 In this instance, Applicant asserts that the Office is combining material from a first reference with that of a second reference wherein the material from the first reference has little or no relationship to the subject matter of the rejected claims or to that of the second reference (i.e., the first reference is non-analogous art). Further, as explained below, the second reference pertains to
25 problems and solutions for hypertext and hypermedia icons in hypertext or hypermedia documents. Applicant asserts that such problems and solutions have little relevance to the problems and solutions addressed by the instant application. Consequently, Applicant submits that the Office erred in rejecting claims 3 and 9-12.

30

Detailed Argument Regarding the Cardinal Reference

The Cardinal reference does not disclose, teach or suggest the subject matter of claims 3 and 9-12. For example, the Cardinal reference does not disclose, teach or suggest “displaying a desktop icon on a desktop, said desktop icon associated with an address of the web site”. The Cardinal
5 reference discloses an item type icon, an attachment icon, a view icon, launching icons and a note file icon (col. 5, ll. 28-36; col. 7, l. 57 – col. 8, l. 21; col. 10, ll. 49-57; col. 11, ll. 20-24). None of these icons are associated with an address of a web site. For at least this reason, Applicant asserts that the Cardinal reference does not alone, or in combination with the Doyle reference,
10 disclose, teach or suggest the subject matter of claims 3 and 9-12.

The Office states correctly that the Cardinal reference does “not go into details that a web site is accessed”. Indeed, the Cardinal reference does not include the word “web”, other than in the Office’s listing of References Cited, none of which list a date earlier than the priority date of the instant application.
15 For at least this reason, Applicant asserts that the Cardinal reference does not, alone or in combination with the Doyle reference, disclose, teach or suggest the subject matter of claims 3 and 9-12.

The Cardinal reference does not mention a “web browser”. Inherently flowing from the previous point, since the Cardinal reference does not mention
20 “web”, it does not mention a “web browser”. The Cardinal reference does mention a “browser”, more specifically an “item browser”; however, as discussed above, there is no evidence of record or indication in the Cardinal reference that such a browser is capable of accessing a web site. For at least this reason, Applicant asserts that the Cardinal reference does not, alone or in
25 combination with the Doyle reference, disclose, teach or suggest the subject matter of claims 3 and 9-12.

Detailed Argument Regarding the Doyle Reference

The Doyle reference does not disclose, teach or suggest the subject
30 matter of claims 3 and 9-12 or what is missing from the Cardinal reference. For

example, the Doyle reference does not disclose, teach or suggest a “displaying a desktop icon on a desktop, said desktop icon associated with an address of the web site.” Instead, the Doyle reference discloses hypertext and hypermedia icons in hypertext or hypermedia documents. As stated in the Doyle reference:

5 A hypertext document is a document that allows a user to view a text document displayed on a display device connected to the user's computer and to access, retrieve and view other data objects that are linked to hypertext words or phrases in the hypertext document (col. 1, lines 61-65).

10

* * *

15 A hypermedia document is similar to a hypertext document, except that the user is able to click on images, sound icons, video icons, etc. [in the hypermedia document], that link to other objects of various media types, such as additional graphics, sound, video, text, or hypermedia or hypertext documents (col. 2, lines 22-27).

According to the Doyle reference, when a user clicks on a phrase “hypermedia” in a hypertext or hypermedia document, which may be
20 represented as a hypermedia icon, software running on the user's computer obtains the link associated with the phrase and the hypermedia is retrieved and displayed on the user's display screen. Doyle at col. 2, lines 37-42.

Applicant submits that none of the various hypertext or hypermedia icons in the hypertext or hypermedia documents are a desktop icon on a desktop as
25 recited in claims 3 and 9-12. Indeed, the Doyle reference does not attempt to solve any problem outside the realm of what is presented by a browser application (i.e., in a hypertext or hypermedia document presented by a browser).

The instant application at pages 6 and 7 describes an icon under the
30 heading “2. Icon”. In an example, a “desktop icon” may be selected and then moved or dragged to a displayed image of a trash can (page 7, lines 1-2). In contrast, the Doyle reference does not disclose any icons capable of being dragged out of a hypermedia document and into a trash can. In general, as explained in the instant application, desktop icons are particular to computer

platforms and operating systems (page 7, lines 13-17) while the hypermedia icons in the hypermedia documents of the Doyle reference must depend to some extent on the documents in which they are contained. Thus, for at least these reasons, Applicant asserts that the Doyle reference does not, alone or in combination with the Cardinal reference, disclose, teach or suggest the subject matter of claims 3 and 9-12. In other words, neither the Doyle reference nor the Cardinal reference discloses a desktop icon on a desktop capable of launching a web browser application.

10 No Motivation to Combine References

Applicant asserts that there is no motivation to combine the Cardinal reference and the Doyle reference. The Cardinal reference is directed to an item browser that helps to keep track of revisions in documents and the Doyle reference is directed to modification of web browser software to parse hypermedia documents (i.e., a modified Mosaic web browser). For example, the Cardinal reference discloses an item browser that pertains to modifications to an item (col. 10, lines 65-67) while the Doyle reference discloses software modifications that allow a web browser to parse a hypermedia document and detect links to data objects in the document (col. 9, lines 24-28).

While it is apparent that the Cardinal reference does not disclose a web browser and that the Doyle reference does not disclose launching a web browser application in response to a user selecting a desktop icon on a desktop; it is also apparent that one of ordinary skill in the art would not be motivated to combine the Cardinal reference and the Doyle reference. In particular, the Cardinal reference (e.g., tracking modifications to items) and the Doyle reference (e.g., parsing hypermedia documents to facilitate display of hypermedia) do not address related problems. Even assuming arguendo that such a motivation existed, the combined references would not teach one of ordinary skill in the art how to arrive at the subject matter of claims 3 and 9-12.

In ¶7 of the Office Action dated August 15, 2002, the Office states that “both systems [Cardinal and Doyle] link resources of information to objects”. Applicant agrees, generally, but maintains that such evidence and reasoning alone would not be sufficient to motivate one of ordinary skill in the art to
5 combine the Cardinal and Doyle references and arrive at the subject matter of claims 3 and 9-12. In particular, the Cardinal reference discloses linking a file and an attachment icon, e.g., consider the word processing document icon 410 of Fig. 4 - “user selection of the attachment icon provides access to the attached file” (col. 6, lines 63-67). The teachings of the Cardinal reference
10 could not be used to modify the teachings of the Doyle reference, or vice versa, to arrive at the subject matter of claims 3 and 9-12. In essence, the Cardinal reference only discloses an item browser, not a web browser, while the Doyle reference pertains to modification of web browser software for parsing hypermedia documents. Again, the evidence is insufficient to support a
15 motivation to combine the two references.

Thus, for the foregoing reasons, Applicant respectfully submits that (i) the Office has not presented evidence sufficient to support a motivation to combine the Cardinal reference and the Doyle reference and that (ii) even if such evidence supported a motivation to combine, the subject matter of claims
20 3 and 9-12 are patentable over the Cardinal reference in view of the Doyle reference because the Cardinal reference and/or the Doyle reference fail to disclose, teach, or suggest the subject matter of claims 3 and 9-12.

For at least the reasons presented above, Applicant asserts that the Office erred in rejecting claims 3 and 9-12 under 35 U.S.C. § 103(a) as being
25 unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). Consequently, Applicant respectfully requests that the Board reverse the Office’s rejection of claims 3 and 9-12.

Group II: Claim 4

Claim 4 was not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). For at least the following reasons, Applicant respectfully submits that the Office erred in rejecting claim 4. More specifically, Applicant submits that the evidence relied upon by the Office does not support the rejections made under 35 U.S.C. § 103(a).

Claim 4 recites a desktop icon associated with a file containing information relating to a web site accessible via a web browser application wherein the web browser application is separate from the file.

Errors in the Rejection

Applicant asserts that the Office erred in rejecting claim 4. In the Office Action dated March 12, 2003, the Office rejected claim 4 and reasoned that the browser in the Cardinal reference may be a separate application which is then accessed and that in the Doyle reference, a separate specific browser is loaded up (column 3, lines 1-10: citation appearing in Office Action of March 12, 2003). Regarding this statement, Applicant asserts that the Office erred in at least two respects. First, the browser in the Cardinal reference is not a web browser and second, the Doyle reference does not disclose loading up a separate specific browser at col. 3, lines 1-10. With respect to the first point, Applicant directs the Board to the foregoing argument regarding the Cardinal reference for claims 3 and 9-12. With respect to the second point, the Doyle reference states:

Typically, the indicator is a very small image and may be a scaled down version of the full image. The indicator may be shown embedded within the text when the text is displayed on the display screen. The user may select the indicator to obtain the full image. When the user clicks on image icon 22 browser software executing on the user's computer system retrieves the corresponding full image, e.g., a bit map, and displays it by using external software called a "viewer." This results in the full image, represented by image 16, being displayed on the screen.

Doyle at col. 1, line 66 to col. 2, line 8 (emphasis added).

Thus, the Doyle reference does not disclose loading up a separate specific browser; instead, it discloses already executing browser software that calls for execution of external software called a "viewer".

5 For at least the reasons presented above, Applicant asserts that the Office erred in rejecting claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). Consequently, Applicant respectfully requests that the Board reverse the Office's rejection of claim 4.

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Group III: Claim 5

 Claim 5 was not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). For at least the following reasons, Applicant
15 respectfully submits that the Office erred in rejecting claim 5. More specifically, Applicant submits that the evidence relied upon by the Office does not support the rejections made under 35 U.S.C. § 103(a).

 Claim 5 is an independent claim directed to a graphical computer system for accessing a desired document located at a network location. Claim 5 recites
20 retrieving the desired document from a network location using a web browser application and a network address via selection of a desktop icon associated with a file containing the network address that corresponds to the network location of the document wherein the web browser application is separate from the file.

25

Errors in the Rejection

 Applicant asserts that the Office erred in rejecting claim 5. In the Office Action dated March 12, 2003, the Office rejected claim 5 and reasoned that the Cardinal reference mentions documents being retrieved and that "the fact that
30 they are retrieved from a network is obvious in view of the Doyle et al ability to

access a website, as described above". Applicant asserts that the Office erred in this reasoning because the Cardinal reference does teach directly or indirectly retrieval of documents using a web browser or a desktop icon capable of executing an instance of a web browser and because the Doyle reference
5 does not address any of the problems associated with the Cardinal reference, like tracking modification history of documents or items. Thus, Applicant submits that one of ordinary skill in the art would not be motivated to combine the Cardinal reference and the Doyle reference and arrive at the subject matter of claim 5. Further, assuming arguendo that such a motivation existed,
10 evidence in these references is insufficient to arrive at the subject matter of claim 5. For example, neither reference refers to a desktop icon on a desktop that is associated with a file wherein selection of the icon uses a web browser to access a document over a network and wherein the web browser is separate from the file. Again, the Cardinal reference does not mention web or web
15 browsers and the Doyle reference does not pertain to desktop icons on a desktop, but rather hypertext and hypermedia documents and parsing of such documents by a modified web browser. As such, Applicant fails to find any relevant evidence as to a desktop icon on a desktop wherein the icon is associated with a file and the file associated with a network location of a
20 document.

For at least the reasons presented above, Applicant asserts that the Office erred in rejecting claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). Consequently, Applicant respectfully requests that the Board
25 reverse the Office's rejection of claim 5.

Group IV: Claims 6, 7 and 8

Claims 6, 7 and 8 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of
30 Doyle (U.S. Pat. No. 5,838,906). For at least the following reasons, Applicant

respectfully submits that the Office erred in rejecting claims 6, 7 and 8. More specifically, Applicant submits that the evidence relied upon by the Office does not support the rejections made under 35 U.S.C. § 103(a).

Claim 6 is an independent claim while claims 7 and 8 depend on claim 6.

5 Claim 6 is directed to a method. Claim 6 recites receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web site. Claim 7 recites receiving an email while claim 8 recites receiving an internet message.

10 Errors in the Rejection

Applicant asserts that the Office erred in rejecting claims 6, 7 and 8. In the Office Action dated March 12, 2003, the Office rejected claims 6, 7 and 8 and reasoned that these claims show the same features as above (i.e., claims 3, 4 and 5) and that "Cardinal et al show the email feature as discussed above",
15 which refers to column 3, lines 56-68 of the Cardinal reference. Applicant asserts that the Office erred in making these statements. First, none of the references disclose, teach or suggest receiving a desktop icon from a second computer system wherein the file contains an address corresponding to a web site and second, while the Cardinal reference mentions "an electronic email
20 message", it does not mention the contents thereof. At column 3, lines 64-66, the Cardinal reference states: "An item consists of an individual piece of data such as a document file or an electronic email message". Thus, Applicant submits that one of ordinary skill in the art would find no evidence in the Cardinal reference that would suggest receiving a desktop icon from a second
25 computer system via email or other means. Applicant further submits that one of ordinary skill in the art would not find any motivation to combine the Cardinal and Doyle references in an effort to arrive at the subject matter of claims 6, 7 and 8.

For at least the reasons presented above, Applicant asserts that the
30 Office erred in rejecting claims 6, 7 and 8 under 35 U.S.C. § 103(a) as being

unpatentable over Cardinal et al. (U.S. Pat. No. 5,799,318) in view of Doyle (U.S. Pat. No. 5,838,906). Consequently, Applicant respectfully requests that the Board reverse the Office's rejection of claims 6, 7 and 8.

5 Conclusion

It is respectfully submitted that the cited art does not render the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. Further, various evidence of record supports non-obviousness of the subject matter of claims 3-12 (e.g., Declaration and articles
10 on INTERNET EXPLORER® software). It is respectfully submitted that claims 3-12, as set forth in Groups I, II, III and IV, should therefore be allowed. The Office has not made a prima facie case of obviousness for any of these Groups. Reversal of the Office's rejections of claims 3-12 is respectfully requested.

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Respectfully Submitted,
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

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Dated: 10-14-03



Name: Brian J. Pangrle

Reg. No. 42,973

Phone No. (509) 324-9256 ext. 231

APPENDIX – PENDING CLAIMS

3. A graphical interactive method for permitting a computer system to access a web site, the method comprising the steps of:

- displaying a desktop icon on a desktop, said desktop icon associated
5 with an address of the web site;
launching a web browser application in response to a user of said
computer system selecting said desktop icon for execution; and
accessing the web site using said web browser application and said
address of the web site.

10

4. A graphical interactive method for permitting a computer system to access a web site, said method comprising the steps of:

- displaying a desktop icon on a desktop, said desktop icon associated
with a file containing information relating to the web site;
15 accessing the web site using an already executing web browser
application and said address for the web, in response to a user of said
computer system selecting said desktop icon for execution, wherein said web
browser application is separate from said file.

20 5. A graphical interactive computer system for accessing a desired document located at a network location, comprising:

means for displaying a desktop icon on a desktop, said desktop icon associated with a file containing a network address corresponding to the network location;

means for enabling a user of the computer system to interactively select
5 said desktop icon for execution;

means for launching a web browser application in response to the user selecting said desktop icon for execution, if said web browser application is not currently executing, wherein said application is separate from said file; and

means for retrieving the desired document from the network location
10 using said web browser application and said network address.

6. A graphical interactive method for permitting a first computer system to access a web site, said method comprising the steps of:

receiving a desktop icon associated with a file from a second computer
15 system, said file containing an address corresponding to web site;

displaying the desktop icon on a desktop of the first computer system;

launching a web browser application in response to a user of the first computer system selecting said desktop icon for execution; and

accessing the web site using said web browser application and said
20 address corresponding to the web site.

7. The method of claim 6, wherein said receiving step comprises receiving an e-mail from the second computer system, said e-mail including said desktop icon.

5 8. The method of claim 6, wherein said receiving step comprises receiving an internet message from the second computer system, said internet message including said desktop icon.

9. One or more computer-readable media having computer-readable
10 instructions thereon which, when executed by a programmable device, launch a web browser application in response to a user of the programmable device selecting a desktop icon on a desktop for execution, the desktop icon associated with an address of a web site accessible by the web browser application.

15

10. A desktop icon for display on a desktop, said desktop icon associated with a web site wherein selection of the desktop icon launches a web browser application and causes the web browser application to access the web site.

20 11. One or more computer-readable media having computer-readable instructions thereon which, when executed by a programmable device in response to selection of a desktop icon displayed on a desktop, the desktop

icon associated an address of a web site, launch a web browser application capable of accessing the web site using the address.

12. A graphical interactive system comprising:

5 means for displaying a desktop icon on a desktop, said desktop icon associated with an address of a web site;

means for launching a web browser application in response to a user of said system selecting said desktop icon for execution; and

10 means for accessing the web site using said web browser application and said address of the web site.